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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MA, JAMESON Q

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1797

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,997	Applicant(s) KORPINEN ET AL.	
	Examiner JAMESON Q. MA	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 18-20, 23-26, 29, 31 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18-20, 23-26, 29, 31 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 31 and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by McNeely et al. (WO 02/072423).

Regarding claim 31, McNeely discloses a cover (see Fig. 1 or Fig. 9: protrusion 20) for an analysis and culture apparatus comprising several wells (see Fig. 1: microplate 10), said cover comprising a separate cap, which can be removably attached to an individual well in order to close the individual well, and to which an inlet passage and an outlet passage for bringing matter to the well and for removing matter from the well, respectively, are integrated (see Fig. 3: inlet and outlet channels 28 and 30), the cap comprising an insert part (see Fig. 2: protrusion 20) which is intended to be placed in the well, said insert part having a lower surface (see Fig. 2: underside 26), and a shoulder (see Fig. 2: the underside of lid 12 is a shoulder) above the insert part, which is configured to be supported by an upper edge of the well, said inlet and outlet passage opening on the lower surface of the insert part.

It is noted that while the described lid has more than one cap or protrusion, that the lid is *fully capable* of covering a single well, and that the limitations of covering an individual well are directed to both intended use of the claimed apparatus and materials worked on.

Regarding claim 33, McNeely discloses all of the claim limitations as set forth above. Additionally, McNeely discloses the cover:

- wherein the cap comprises a flange part being wider than the insert part and having a lower surface forming said shoulder (see Figs. 1 & 2: lid 12 is a flange part).

Regarding claims 34-35, McNeely discloses all of the claim limitations as set forth above. Additionally, McNeely discloses the cover:

- wherein there is a seal around the insert part, which seal is placed against a side wall of the well (see Fig. 3 and P7/L18-24).

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 16, 18-20, 23-26, and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over McNeely et al. (WO 02/072423) in view of Smith et al. (US 4,968,625).

Regarding claim 16, McNeely discloses an analysis and culture apparatus comprising a well plate comprising several wells having depth directions (microplate 10), and caps (Fig. 9 and P9/L25-30) to close the wells to form closed spaces wherein the caps can be removably attached in the wells, and have an inlet passage and an outlet passage integrated in the cap for introducing matter to the closed space and for removing it from the closed space, respectively, the caps further comprising an insert part (see Fig. 2: protrusion 20) configured to be placed in the well, said insert part configured to be placed in the well, said insert part having a lower surface (see Fig. 2:

Art Unit: 1797

underside 26), and a shoulder (see Fig. 2: the underside of lid 12 is a shoulder) supported by an upper edge of the well, said inlet passage and outlet passage opening on the lower surface of the insert part.

McNeely discloses that it is not necessary for the lid to interface with all of the wells of a microplate, as is evidenced by Figure 9. McNeeley discloses that the lids have inlets and outlets for the introduction of fluid volumes to samples. It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate multiple lids (and thus multiple *and* separate caps) in the apparatus of McNeely so that multiples types of fluid samples and reagents may be added to the samples in separate wells concurrently, or alternatively in the same wells at different times without the need for sterilization of lids to add separate reagents.

Modified McNeely discloses all of the claim limitations as set forth above. Additionally, McNeely discloses that the top plate of the lid can be made of durable materials, such as hard plastic (see P13/L10-11).

Modified McNeely does not explicitly disclose the apparatus wherein the cap is transparent in the depth directions of the well.

Smith teaches that vials and trays for multiwells can be made of polyethylene terephthalate (see abstract and C6/L40-54: polyethylene terephthalate is a transparent hard plastic).

It would have been obvious to one of ordinary skill in the art to make the lid of modified McNeely, with polyethylene terephthalate as taught by Smith, because doing

Art Unit: 1797

so would result in nothing more than choosing from a finite number of identified, predictable solutions for hard plastics, with a reasonable expectation of success.

Regarding claim 18, modified McNeely discloses all of the claim limitations as set forth above. Additionally McNeely discloses the apparatus:

- wherein the cap comprises a flange part being wider than the insert part and having a lower surface forming said shoulder (see Figs. 1 & 2: lid 12 is a flange part).

Regarding claims 19 and 20, McNeely discloses all of the claim limitations as set forth above. Additionally McNeely discloses the apparatus:

- wherein there is a seal around the insert part, which seal is placed against a side wall of the well (see Fig. 3 and P7/L18-24).

Regarding claims 23 and 24, McNeely discloses all of the claim limitations as set forth above. Additionally McNeely discloses the apparatus:

- wherein the inlet passage opens at a lower position than the outlet passage (see Fig. 3: if the disclosed figure is rotated 90 degrees counter-clockwise, inlet opening 22 opens at a lower position than outlet opening 24).
- wherein, in order to couple the inlet and outlet channels to the cap (see Fig. 3: inlet and outlet channels 28 and 30 are already coupled to the cap), there are connection apertures on the outer surface of the flange part (see Fig. 1: inlet and outlets 17 and 19 can be viewed as connection apertures).

Regarding claims 25 and 26, McNeely discloses all of the claim limitations as set forth above. Additionally McNeely discloses the apparatus:

- wherein there is an inclined portion on the lower surface of the insert part (see Fig. 3: the vertical sidewalls that define openings 22 and 24 are inclined with respect to interface layer 32).

Regarding claim 29, McNeely discloses all of the claim limitations as set forth above. Additionally McNeely discloses the apparatus:

- wherein separate input channels are brought to the caps placed in the wells (see Figs. 1 and 2: each protrusion 20 has its own separate input channel).

Response to Arguments

5. Applicant's arguments with respect to claims 16, 18-20, 23-26, and 29 have been considered but are moot in view of the new ground(s) of rejection. Arguments with respect to claims 31 and 33-35 are not persuasive because the caps disclosed the McNeely are fully capable of covering a single well. It is noted that a recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art, if the prior art has the capability to so perform. It is further noted that neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, it has been held that process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states "Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim."

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMESON Q. MA whose telephone number is (571)270-7063. The examiner can normally be reached on M-R 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

July 31, 2009

Application/Control Number: 10/553,997
Art Unit: 1797

Page 8